UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,447	10/08/2003	Alan Kyle Bozeman	SGI-20-CIP	9400

22827 7590 11/23/2007

DORITY & MANNING, P.A.
POST OFFICE BOX 1449
GREENVILLE, SC 29602-1449

EXAMINER	
SAGER, MARK ALAN	
ART UNIT	**PAPER NUMBER**
3714	

MAIL DATE	DELIVERY MODE
11/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/681,447	BOZEMAN, ALAN KYLE	
	Examiner	Art Unit	
	M. A. Sager	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-9,21,23 and 25-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-9,21,23 and 25-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Interpretation

1. With respect to claim interpretation for clarification of record, the language 'alphabetical play phrase' (or similar terminology) includes any coherent text or any text or a word or includes an alphanumeric sequence as per Applicants specification (abstract, paragraphs 45, 52, 58-59, 62-63, 79, 82, 86) that although specification (paragraph 82) includes listing that the play phrase is quotes, film titles, fortune cookies or even simple list of words fitting a theme, the language is broader and includes any text at least since that although Applicant may be their own lexicographer, in this instance, Applicant did not provide a clear definition (paragraph 32) and the examples cited in the listing (para 82) are merely examples. The claim language 'play phrase that comprises a plurality of words' does not require the plurality of words to be a sequence of words regarded as a meaningful unit or that there exists a relationship between any of the plurality of words as presently claimed since no such relationship is defined as claimed and is neither implicit nor inherent. Applicant is cautioned against improperly reading function or features into claims from specification. Also, in consideration of intrinsic evidence, the specification permits letters, alphanumeric, numbers, symbols as characters or indicia and that a player may enter a word or any coherent text can form the play phrase or can be any text at least since specification states a player may write the desired word and states any coherent text (abstract, paragraphs 58-59, 62-63, 79). Further, in consideration of extrinsic evidence, phrase is defined within Webster's II New Riverside University Dictionary, copyright 1994, to be (1) a sequence of words regarded as a meaningful unit or, (2) a concise or familiar expression: CATCH PHRASE or, (3) a word or group of words read or spoken as a unit and separated by pauses or other junctures or, (4) two or more words in sequence comprising syntactic unit or

groups of syntactic units, less completely predicated than a sentence. In consideration of specification as a whole (by itself or, in conjunction with extrinsic evidence), the broadest reasonable interpretation of the claimed invention including 'alphabetic play phrase' (or similar language) is any coherent text that may include a word, and a series of letters or numbers or alphanumeric is coherent text. Also, a single word is any text and a word can form a phrase or sentence such as but not limited to GO, NO, STOP, HALT, or further text includes CLOUD 9 or B5 or I21, as broadly claimed. Further, alphabetic of alphabetic play phrase is deemed to limit invention to require letters or alphanumeric; while, word-based play phrase is deemed to require word(s), however, although alphabetic play phrase requires letters, it is not limited to word(s). Further, text such as B5, I18, N38, G50, and O72 is an alphabetic play phrase as coherent text of an alphanumeric sequence from a lotto game of bingo deemed inclusive within breadth of claimed invention. Also claimed invention including 'play phrase comprising a plurality of words', the breadth of claim language includes a plurality of words that may include words associated or relate to a topic or theme similar to word find or search puzzles that include a plurality of words related to a topic or theme; however, presently no relationship between the plurality of words is required.

Double Patenting

2. 1, 3, 5-9, 21, 23, 25-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 29-38, 40-47 and 49 of copending Application No. 10662736. Although the conflicting claims are not identical, they are not patentably distinct from each other because applicant is entitled per statute to one patent for one invention whereas instant claimed invention is anticipated by or obvious form of the

apparatus and method of Bozeman's '736 claims. For instance, Bozeman '736 claimed game input unit is presently claimed lottery input unit, Bozeman '736 claimed game input unit as a touch-screen device is presently claimed display unit, Bozeman '736 claimed controller is presently claimed controller where claimed functions or process is/are performed/conducted by Bozeman '736 apparatus/method.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. Claim 1, 3, 5-7 and 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language 'from a user' and 'by a person' is unclear as to whether the phases refer to same individual or whether each refers to different individual such as one may be an lottery operator and the other a player; however, for examination purposes, the language is examined as if refer to same.

Claim Rejections - 35 USC § 102/103

4. Claims 21, 23, 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Guttin (6241246). Guttin discloses a game ticket for playing a lottery game (abstract, 1:5-12, 1:45-2:11, 2:43-56, figs. 1-5) teaching storing an alphabetical play phrase having a plurality of words defined by a plurality of characters as a listing of words fitting a theme on a preprinted game card or lotto ticket (ref 2, 6), assigning a prize value to each of the words in the play phrase (ref 8), randomly generating a alphabetical sample comprising a random string of letters (ref 4), matching the letters in the alphabetical sample to the plurality of characters defining said words

in the play phrase (4:27-59, 6:30-35), determining a win status based on the number of matched words in the play phrase (ref 8) implicitly includes defining a price point (conventional lotto tickets sell for $1US) and implicitly includes basing award prize as a function of the price point (ref 8), defining a sample size of the number of alphabetic indicia to be drawn during a round of word based lottery game play (6:21-29), storing a predefined/custom play phrase as a list of words fitting a theme (ref 6). No differentiation is claimed with respect to 'predefined' and 'custom' play phrase and no import from specification is permitted at least since no 112(6) issue is present.

5. Claims 1, 3, 5-7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Koza (5112050) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Koza (5112050) in view of either Baerlocher (5788573) or Walker (5921864). This holding is maintained from office action mailed August 02, 2007 for invention as defined by cited claims which is incorporated herein but clarified next. Response to Applicants remarks is provided below and incorporated herein. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swine hart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)

(emphasis in original). Where play phrase includes any text (sic) and where 'configured to receive a play phrase from a user comprising a plurality of words' is functional recitation regarding manner of use, in this case, claimed invention fails to patentably distinguish over apparatus and method of Koza since Koza discloses a apparatus and method as a lottery terminal apparatus and network lottery game in a network of terminals including first and second lottery terminal apparatus having respective first and second controller in communication to perform lottery functions (2:51-3:20, 3:43-4:4, 4:13-5:28, 6:9-12, 6:21-39, 11:28-68, 12:36-13:30, figs. 1-6) teaching claimed features performing claimed steps, as broadly claimed, including a lottery input unit configured to receive a play phrase from user as a word or letters that playing [i.e. process of use] over a plurality of games implicitly includes a plurality of words (2:51-3:20, 3:50-52, 6:9-29, 11:14-68, 12:36-63, ref 10, 70-72), a display unit for visually displaying received alphabetical game play information (ref 42), a value input device such as a coin slot, keyboard, impregnating device or play slip or card reader as a value acceptor (3:10-20, 3:50-52, 6:9-29, 11:28-38, 11:60-68, 12:36-63, ref 19, 72), a wager input device such as coin slot (11:40), a controller operatively coupled to display unit and value input unit and to a network interface device (2:51-3:20, 8:65-11:2, 11:28-13:2, fig. 1-6, or inherent, per MPEP 2131.01, see either Goldman 3:61-5:40, ref 12; or Luciano, 2:66-3:9, 5:66-6:3, 7:20-9:15, ref 130), the controller programmed to receive a wager in response to wager made by a player (11:39-40), programmed to assign a prize value to received play phrase or to each of the words in the play phrase where play phrase includes a word that is a phrase or sentence and prize value is per pay table that is based in part on degree and/or order of matching indicia including numbers and/or letters of word (3:10-20, 5:26-28, 5:31-32, 49-51, 7:25-58, 8:4-5, 9-11, 12:36-13:2 or inherent, per MPEP

2131.01, see either Goldman 3:61-5:40, ref 12; or Luciano, 2:66-3:9, 5:66-6:3, 7:20-9:15, ref 130), programmed to randomly generate an alphabetic sample comprising a random string of letters and determine a correlation between alphabetic sample and play phrase (3:10-20, 4:51-54, 5:24-28, 6:32-39, 7:25-66, 8:4-11, 11:28-13:2 or inherent, per MPEP 2131.01, see either Goldman 3:61-5:40, ref 12; or Luciano, 2:66-3:9, 5:66-6:3, 7:20-9:15, ref 130), determine a payout value based on correlation between alphabetic sample and play phrase and prize value (2:51-3:20, 3:64-4:12, 6:21-43, 7:26-41, 7:48-58, 9:41-68, 12:36-13:16), the memory stores a probability distribution indicative of frequency at which each alphabetic character occurs (12:36-13:2, implicit in consideration of repetition of any particular indicia within set of symbols/words) causes a video image to be generated on display unit representing a lottery game (supra), a wireless networking device (4:18-36, 6:49-68), transmits lottery information on a secure wireless network (5:58-60). Also, a plurality of words is not structure that overcomes structure taught by Koza since Koza teaches a lottery input unit configured to receive a play phrase as a word where the word is also a phrase where play over multiple games includes a plurality of words such as text or a list of words fitting a theme of a lottery word game (sic). Further, regarding determining a payout value, Koza provides a payout value based upon a correlation among the character string, the alphabetical play phrase, the prize value and the wager as a matching of letter grouping (sic). It is noted that Applicants' instant specification includes determining a payout value based upon matching letter group or grouping that is one form of determining a payout encompassed by clam language in a similar manner taught by Koza, thus claimed functional recitation in apparatus fails to preclude Koza. Essentially, claimed structure/use of invention fails to patentably distinguish over teachings of Koza.

Alternatively, although not believed necessary by scope of invention for claiming an apparatus (supra), Koza teaches receipt of a play phrase as a word in each game (sic), but lacks a plurality of words where the play phrase comprises a plurality of words for each game (not currently claimed as limiting and would be functional). However, use of a play phrase that comprises a plurality of words in games of chance is known as taught by either Baerlocher or Walker. Further, a game of chance including a plurality of words in a phase is taught in Wheel of Fortune phrase game as discussed by Baerlocher (1:21-27, 4:4) or Walker (abstract, 4:18-19 and 23-35). It is reiterated that difference in indicia from number selection to letter or word selection fails to patentably distinguish in so far as type of indicia used [number vs. alphabet vs. alphanumeric symbols vs. word vs. words vs. phrase] in a lotto game fails to distinguish over art or in so far as alteration of odds by use of alphabetic or alphanumeric indicia or word or words or phrase vs. number range is maintained as obvious for alteration of odds and design choice of indicia used. So as to be clear for the record, use of alphabet, words or phrase that comprises a plurality of words in a lotto or lottery scheme is merely choice of symbol/indicia which is not deemed patentable over a lottery that uses another set of symbols/indicia such as numbers or a word at least since changing odds by using 26 letters of alphabet (36 for alpha-numeric) or another range rather than ten digits (0-9) or a plurality of words is like differing lottery forms of pick-3 vs pick-4 vs pick-6 in that each is picking a number of indicia to match while a phrase that comprises a plurality of words is picking a plurality [i.e. number] of words to match similarly fails to patentably distinguish over conventional lottery game (altering odds of game of chance is known/obvious for causing larger jackpots/awards while lowering probability of matching indicia so as to attract player participation and thus increase revenue through increased

play). Of note, invention does not require a relationship among the plurality of words that may be a listing of words fitting a theme. However, a phrase that comprises a plurality of words is similar to a plurality of indicia such as in conventional lotto games where words or a phrase containing a plurality of words or the letters of the words are the indicia that may be order specific. Koza teaches a plurality of indicia with respect to win determination that is deemed teaching or suggesting a plurality of indicia including numbers, letters or word (7:31-32, 36-41, 48-58, 12:36-13:2). Koza further suggests order specificity of indicia of numbers or letters (7:25-58, 12:35-13:2). Baerlocher and Walker each teach use of play phrase that comprises a plurality of words in chance game. Thus, it would have been obvious to an artisan at a time prior to the invention to add 'words in a phrase' as taught/suggested by either Baerlocher or Walker to Koza so as to increase interest from players for particular topic or theme. Essentially, in this case, the particular indicia selected by player or generated as winning combination fails to patentably distinguish over Koza at least since games of chance that include a phrase having a plurality of words are known such as phrase game taught by either Baerlocher or Walker suggest a phrase comprising a plurality of words so as to increase the complexity of game and increase size of jackpot prize due to decreased probability of winning.

6. Claims 21, 23, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koza in view of either Guttin (6241246) or Baerlocher ('573) or Walker ('874). This holding is maintained from office action mailed August 02, 2007 for invention as defined by cited claims which is incorporated herein but clarified next. Response to Applicants remarks is provided below and incorporated herein. Koza discloses claimed invention including a word as a phrase or sentence including a word as an alphabetic play phrase (sic), the plurality of characters of play

phrase implicitly includes a letter distribution, defining a price point and percentage return (7:26-8:17), implicitly defines a sample size of indicia to draw (1:14-2:3, 2:47-3:20, 6:21-43, 7:26-33, 9:41-54, 12:35-13:2), stores list of play phrases (12:24-62), storing a custom play phrase (5:24-28, 6:9-12, 44-48), randomly selecting alphabetic indicia (12:24-62), matching alphabetic indicia to a plurality of characters (12:24-62), determining a win status (12:24-62), but lacks alphabetic play phrase having a plurality of words in each game and Koza includes assigning a prize value to a play phrase having a word that is any coherent text or where word is a phrase (supra), Koza lacks assigning a prize to each word in a play phrase of a plurality of words. A phrase having a plurality of words in a game of chance is taught/demonstrated in Wheel of Fortune phrase game as discussed by Baerlocher (1:21-27, 4:4) or Walker (abstract, 4:18-19 and 23-35) or, alternatively as taught by Guttin (abstract, 1:46-2:14, Figs. 1-4) where the play phrase including a plurality of words includes any text or a listing of words fitting a theme such as a theme of a word lottery game (sic). Koza teaches a plurality of indicia with respect to win determination that is deemed teaching or suggesting a plurality of indicia including letters or word but deemed obvious where words is the indicia (7:31-32, 36-41, 48-58, 12:36-13:2). Koza further suggests order specificity of indicia (7:25-58, 12:35-13:2). Thus, it would have been obvious to an artisan at a time prior to the invention to add 'plurality of words' as taught/suggested by either Baerlocher or Walker or Guttin to Koza so as to increase interest from players for particular topic or theme. Essentially, in this case, the particular indicia selected by player or generated as winning combination fails to patentably distinguish over Koza at least since games of chance that include a phrase having a plurality of words are known such as phrase game taught by either Baerlocher or Walker or a phrase as a listing of words fitting a theme as taught by Guttin suggest

a play phrase comprising a plurality of words so as to increase the complexity of game and increase size of jackpot prize due to decreased probability of winning. Further regarding assigning a prize value to each of the words in a play phrase that includes a plurality of words, Koza teaches assigning a prize value to a play phrase and based in part on partial matching (supra) but not where the play phrase includes a plurality of words. Guttin further teaches assigning a prize value to each of the words in a play phrase that contains a plurality of words (ref 8). Thus it would have been obvious to an artisan at a time prior to the invention to add assigning a prize value to each of the words in the play phrase as taught by Guttin to Koza in view of either Baerlocher or Walker or Guttin to provide payout based in part on number of words matched.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koza in view of either Itkis (4856787) or Luciano (6168521) or, in the alternative, over Koza in view of either Baerlocher or Walker as applied to claim 1 above, and further in view of either Itkis or Luciano. Koza or Koza in view of either Baerlocher or Walker discloses claimed invention (supra) but lacks touch-screen. Itkis and Luciano each disclose apparatus for lotto play teaching use of touch-screen for input of game play information since a touch-screen permits input directly to display screen. Thus, it would have been obvious to an artisan to add touch-screen as taught by either Itkis or Luciano to Koza or to Koza in view of either Baerlocher or Walker to permit direct input or so as to permit reduction or elimination of additional player input device(s).

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koza in view of Anderson (6428412) or Scrabble or in the alternative, over Koza in view of either Baerlocher or Walker as applied to claim 1 above, and further in view of either Anderson or Scrabble. Koza or

Koza in view of either Baerlocher or Walker discloses claimed invention (supra) but lacks wildcard. It is notoriously well known in gaming to include wild symbols for player formulation of player input/hand in win determination that generally increases probability of forming a win combination when a player has a wildcard to be used. Anderson and Scrabble each disclose a word game that includes wildcard indicia for word formulation. Thus, it would have been obvious to an artisan to add wildcard as taught by either Anderson or Scrabble to Koza or to Koza in view of either Baerlocher or Walker to permit direct input to output device or so as to increase probability of forming a win combination whenever a player has a wildcard to be used which increases player interest to continue playing and increasing revenues thereby from the increased or continuance of play.

9. 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koza in view of either Guttin or Baerlocher or Walker as applied to claim 21 above, and further in view of Roberts. Koza in view of either Baerlocher or Guttin or Walker discloses invention (supra) except preprinted card game. Koza discusses preprinted card games as known forms of lotto presentation (1:14-2:44, esp. 2:16-39). Roberts discloses a lotto game teaching a preprinted card game (abstract, 1:58-3:4, 4:14, 22-46, figs. 1-8B, ref 19). Since some players prefer preprinted card game as a tangible non-electronic form of lotto play, it would have been obvious to an artisan at a time prior to the invention to add preprinted card game as taught by Roberts to Koza in view of either Baerlocher or Guttin or Walker so as to provide a form of lotto that is preferred by some players who like the tangible form over an electronic game form.

Response to Arguments

10. Applicant's arguments with respect to claims 21, 23, 25-28 have been considered but are moot in view of the new ground(s) of rejection. Amended method is drafted into teachings of Guttin.

11. Applicant's arguments filed 11/2/07 have been fully considered but they are not persuasive. Applicant's admission on page 14 of amendment filed 8/23/07 in parent application 10662736 that a phase can include a single word is noted. Also, from above claim interpretation, the claim language 'play phrase that comprises a plurality of words' does not require the plurality of words to be a sequence of words regarded as a meaningful unit or that there exists a relationship between any of the plurality of words as presently claimed since no such relationship is defined as claimed and is neither implicit nor inherent. Applicant is cautioned against improperly reading function or features into claims from specification and the Applicant did not provide a clear definition or act as a lexicographer in this instance (para 32). Disclosure includes a listing of words fitting a theme that includes a theme of a word based lottery game.

In response to Applicant's remark that Koza lacks a plurality of words, the claimed invention is an apparatus (with respect to claim 1, 3, 5-9) and an apparatus must be differentiated by its structure not its manner of use (sic). The office maintains that the structure claimed is taught by Koza either implicitly or explicitly since Koza teaches a lotto game that uses a word which in those instances that the word also is a phrase, having a game input unit, a wager input device and a controller (sic). Also, use of Koza's apparatus over a plurality of games implicitly includes a plurality of words as a listing of words fitting a theme such as a word lottery game. Alternatively, the use of a plurality of words is maintained as design choice for altering

probability or odds of game similar to the various lotto (pick-3, pick-4, pick-6, keno) games having a differing number of indicia (i.e. numbers) selected for altering odds based on number of indicia to be matched and the ranges of numbers being used (supra). Baerlocher or Walker each suggests games of chance having use of a plurality of words in a phrase. Thus, the combination (Koza in view of Baerlocher or Walker) taken as a whole at a time prior to the invention suggests to an artisan a lottery game that receives a alphabetical play phrase from a user comprising a plurality of words so as to increase jackpot size resultant from the decrease in probability to match. Also, in response to applicant's argument that Koza lacks a phase that comprises a plurality of words, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, Koza teaches providing a phrase where a word is a phrase and over the course of a plurality of games includes a phase as a listing of words fitting a theme of a word lottery game that comprises a plurality of words. Alternatively, the combination of Koza in view of either Baerlocher or Walker taken as a whole at a time prior to the invention suggests to an artisan a lottery apparatus comprising a lottery input unit configured to receive a play phrase from a user that comprises a plurality of words, a value input unit, a controller as particularly claimed so as to increase the complexity of game and increase size of jackpot payout thereby and increase revenue from increased play resultant form the larger jackpot (sic). As further evidence only, although not deemed necessary for holding, Sarno further provides evidence of lottery game where a user selects a plurality of words as indicia to match as noted by use of the plural form 'words' (5:45-52).

In response to applicant's remark that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner disagrees with Applicants assertion that the references teach away from claimed invention since the standard of patentability remains as what the combination of prior art suggests to an artisan taken at a time prior to the invention. Koza, Baerlocher and Walker each teach a method of play, but this does not teach away from invention. In this case, Koza discloses a lottery game where the player selects the indicia to match via game input of either play slip or keyboard (3:10-20, 3:50-52, 6:9-29, 11:36-38, 11:60-68, 12:46-63, ref 72); while, either Baerlocher or Walker each suggest use of phrase comprising a plurality of words in a chance game. Although the phrase is hidden in either Baerlocher or Walker, the holding is not relying on player selection from either of those references, since player selection of a phrase is taught by Koza since as applicant admits a word may be a phrase in those instances that the word is a phrase and Koza includes player selection of a phrase by selection of a word in those instances that the word is a phrase. Thus, the combination taken as a whole at a time prior to the invention suggests to an artisan a lottery game where a user selects a phrase comprising a plurality of words on an input device. As further evidence only, although not deemed necessary for holding, Sarno further provides evidence of lottery game where a user selects a plurality of words as indicia to match as by use of the plural form 'words' (5:45-52).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The standard of patentability remains as what the combination taken as a whole suggests to an artisan at a time prior to the invention. In this case, the combination of Koza in view of either Baerlocher or Walker taken as a whole at a time prior to the invention suggests to an artisan a lottery apparatus comprising a lottery input unit configured to receive a play phrase from a user that comprises a plurality of words, a value input unit, a controller as particularly claimed so as to increase the complexity of game and increase size of jackpot payout thereby and increase revenue from increased play resultant form the larger jackpot (sic). As further evidence only, although not deemed necessary for holding, Sarno further provides evidence of lottery game where a user selects a plurality of words as indicia to match as noted by use of the plural form 'words' (5:45-52).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a user provides a play phrase consisting of a plurality of words) are not recited in the rejected claim(s) pertaining to the method (claims 21, 23, 25-28) and is neither implicit nor inherent. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. A. Sager
Primary Examiner
Art Unit 3714

mas